

Notice of Allowability

Application No.

09/515,158

Examiner

Harold E. Dodds, Jr.

Applicant(s)

QUERNEMOEN ET AL

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 30 April 2004 and 13 October 2004.
2. ☒ The allowed claim(s) is/are 1, 3, 10-16, and 19 (renumbered 1-10).
3. ☒ The drawings filed on 29 February 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Harold E. Dodds, Jr.
Patent Examiner

REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance: The Examiner finds Applicant's arguments on pages 2-3 of the "Response to Rule 1.105 Requirement" filed 27 April 2004 and on page 7 of the "Amendment" and filed 13 October 2004, concerning method for sizing the hardware resources for a yet-to-be built database management system persuasive as applied to independent claim 1. The combinations of prior art from Stellwagen, Jr. (U.S. Patent No. 5,835,755) and Robinson et al. (U.S. Patent No. 6,263,433) do not render obvious nor anticipate the combination of recited elements in light of claim 1 as amended by the "Amendment" filed on 13 October 2004. The "Response to Rule 1.105 Requirement" meets all criteria that show the invention claimed in claim 1 was invented by the applicant prior to the filing date of the Yang et al. (U.S. Patent No. 6,542,854) patent on 30 April 1999, which was used to render obvious independent claim 1 in previous office actions. No adequate prior art with an earlier filing date has been found to replace the Yang patent. The affidavit relates the invention to a file containing an E-mail message of an updated version of the NT sizer program, which was completed and distributed to a number of recipients prior to 30 April 1999. The distribution to number of recipients meets the corroboration requirement "in order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence" per *Cooper v. Goldfarb*, 154 F.3d 1321, 1330, 47 USPQ2d 1896, 1903 (Fed. Cir. 1998). The NT Sizer User Guide was not published prior to 28 February 1999, which is one year prior to the filing date of

the patent application. The affidavit maps the elements in the independent claims to the corresponding elements in the disclosure of the NT Sizer User Guide.

2. The Examiner finds Applicant's arguments on pages 2-3 of the "Response to Rule 1.105 Requirement" filed 27 April 2004 and on page 7 of the "Amendment" and filed 13 October 2004, concerning a computerized method for calculating hardware resource requirements for a yet-to-be built database management system computer persuasive as applied to independent claim 16. The combinations of prior art from Stellwagen, Jr. (U.S. Patent No. 5,835,755), Robinson et al. (U.S. Patent No. 6,263,433), and Fanshier (U.S. Patent No. 5,841,972) do not render obvious nor anticipate the combination of recited elements in light of claim 16 as amended by the "Amendment" filed on 13 October 2004. The "Response to Rule 1.105 Requirement" meets all criteria that show the invention claimed in claim 16 was invented by the applicant prior to the filing date of the Yang et al. (U.S. Patent No. 6,542,854) patent on 30 April 1999, which was used to tender obvious independent claim 16 in previous office actions. No adequate prior art with an earlier filing date has been found to replace the Yang patent. The affidavit relates the invention to a file containing an E-mail message of an updated version of the NT sizer program, which was completed and distributed to a number of recipients prior to 30 April 1999. The distribution to number of recipients meets the corroboration requirement "in order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence" per *Cooper v. Goldfarb*, 154 F.3d 1321, 1330, 47 USPQ2d 1896, 1903 (Fed. Cir. 1998). The NT Sizer User Guide was not published prior to 28 February 1999, which is one

year prior to the filing date of the patent application. The affidavit maps the elements in the independent claims to the corresponding elements in the disclosure of the NT Sizer User Guide.

CONCLUSION

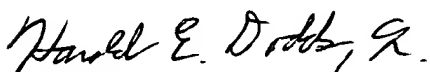
3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold E. Dodds, Jr. whose telephone number is (571)-272-4110. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571)-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Harold E. Dodds, Jr.
Patent Examiner
March 1, 2005